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EXAMINER

NICKERSON, JEFFREY L

ART UNIT	PAPER NUMBER
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4117

NOTIFICATION DATE	DELIVERY MODE
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10/11/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/522,749

Applicant(s)

SHIMIZU, JUNICHI

Examiner

Jeffrey Nickerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 28 January 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Application No. 10/522,749 filed on 28 January 2005. The preliminary amendment, which provides change to the abstract, provides change to claim 1, 4, 8, 9, 10, 11, and 17, is hereby acknowledged. Claims 1-17 have been examined.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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3. The abstract of the disclosure is objected to because of the phrase "An object of the present invention is to provide" in the first sentence. This phrase falls into the category of implied phraseology and should be removed. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoneyama (US 2003/0064707 A1).

Regarding claim 1, Yoneyama teaches wherein an e-mail viewing device (portable telephone) comprising:

a mail storage (storage portion) storing a plurality of e-mails; (Yoneyama: Figure 1, item 204; [0029] specifies that the storage portion stores key words, etc., and then

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the display portion retrieves past e-mail messages, implying they are stored in the storage portion)

a display processor (display portion) displaying an e-mail stored in said mail storage onto a mail viewing screen; (Yoneyama: Figure 1, item 5; [0029] specifies retrieving email messages in order to display them)

an operation input unit (operation portion) for a user to enter a mail switching operation (clicking) for switching an email on the mail viewing screen; (Yoneyama: Figure 1, item 3; abstract specifies switching between messages by simply clicking)

a mail search portion (message search processing means) for an email stored in said mail storage on the basis of the email displayed on the mail viewing screen; (Yoneyama: Figure 1, item 2a; abstract specifies retrieving related email messages based off searching for the currently received message's keywords.)

said display processor displays the email extracted by said mail search portion on the basis of the mail switching operation of the user (Yoneyama: abstract specifies switching between the received message and retrieved messages by clicking).

Regarding claim 2, Yoneyama teaches wherein

said mail search portion extracts an email whose sender or address matches the sender of an incoming mail displayed on the mail viewing screen. (Yoneyama: [0013] specifies the searching by keywords; [0034] specifies the keyword is a sender's name; [0039] specifies the sender's name is the sender of the currently received message)

Regarding claim 3, Yoneyama teaches wherein

said mail storage stores an outgoing mail and an incoming mail; (Yoneyama: [0005] implies the use of outboxes and inboxes in the prior art; [0034]-[0037] specify the use outboxes and inboxes for searching, implying they're used for storing)

said mail search portion checks with the address of an outgoing mail or the sender of an incoming mail. (Yoneyama: [0040]-[0044] specify the selectively searching either the inbox, outbox, or both; [0034] specifies searching for a sender's name)

Regarding claim 4, this device claim comprises limitations substantially similar to those of claim 1 and the same rationale of rejection is used, where applicable. Yoneyama further teaches wherein

an email search portion searching for an email stored in said mail storage on the basis of the email designated by the user (Yoneyama: [0011] specifies that the searching is done based on the currently displayed message; [0015] specifies further that the searching is based off the currently displayed message and that the user has control over which message is displayed, thereby designating which message to use as a search basis)

Regarding claim 5, Yoneyama teaches wherein

said mail storage stores an email together with transmission/reception time (date) of the email; (Yoneyama: Figure 5a and Figure5b; Also Figure 4d all indicate emails are stored with date/time information)

said mail search portion extracts emails matching a search condition in time sequence of the transmission/reception times; (Yoneyama: [0040]-[0043] indicate a search based on inbox and outbox; Figure 6f and Figure 6h indicate that search results are returned sorted by date/time information)

and display processor sequentially switches and displays an email extracted by said mail search portion on the basis of a mail switching operation of the user.

(Yoneyama: [0060] specifies scrolling through the returned search messages by single clicking)

Regarding claim 6, Yoneyama teaches wherein

a movement direction on the time base is designated by the user as a mail switching operation on said operation input unit (Yoneyama: [0049] specifies that following messages are switched to by clicking 'Next' and that earlier messages are switched to by clicking 'Previous')

said mail search portion sequentially extracts emails matching the search condition in the movement direction on said time base (Yoneyama: [0049] specifies that the messages are switched to whether being earlier or following; Figures 6f and 6h indicate that the search results are sorted by date/time)

said display processor sequentially switches and displays the emails extracted by said mail search portion each time the user performs a mail switching operation.

(Yoneyama: [0049] specifies that scrolling the list and sequentially opening retrieved emails is possible without closing the reference emails)

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Regarding claim 7, Yoneyama teaches wherein

an email designated by the user is an email displayed on the mail viewing screen when the mail switching operation is performed for the first time. (Yoneyama: [0015] specifies that searching is based off the currently displayed and that search results are then turned into the currently displayed item, implying it would be capable of searching based off a search result or after a switching has occurred)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama (US 2003/0064707 A1), and further in view of Lee et al (US 2002/0032743 A1).

Regarding claim 8, Yoneyama teaches an email editing device comprising:

a mail storage (storage portion) storing a plurality of reference mails;
(Yoneyama: Figure 1, item 204; [0029] specifies that the storage portion stores key words, etc., and then the display portion retrieves past e-mail messages, implying they are stored in the storage portion)

a display processor (display portion) displaying an e-mail stored in said mail storage onto a mail viewing screen; (Yoneyama: Figure 1, item 5; [0029] specifies retrieving email messages in order to display them)

a temporary storage (storage portion) storing data; (Yoneyama: Figure 1, item 204; [0029] specifies that the storage portion stores key words, etc., indicating it stores reference emails and other things)

a reference processor (control portion) copying an object in a reference mail to said temporary storage; (Yoneyama: [0053] specifies that you can copy from the reference email, implying it is stored in the storage portion)

an editor pasting the object in said temporary storage into an email; (Yoneyama: [0053] specifies that you can paste information into an email)

an operation input unit (operation portion) for a user to enter a mail switching operation (clicking) for switching a reference mail on the mail reference screen;
(Yoneyama: Figure 1, item 3; abstract specifies switching between retrieved messages by simply clicking; [0058] specifies it can be done by a single click without going back to the search results)

a mail search portion searching for the reference mail stored in said mail storage on the basis of the mail displayed on the mail screen (Yoneyama: Figure 1, item 2a;

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[0011] specifies retrieving related email messages based off searching on the basis of the currently displayed message)

said display processor displays the reference mail extracted by said mail search portion onto the mail reference screen on the basis of the mail switching operation of the user (Yoneyama: abstract specifies displaying retrieved emails based off the search onto the display screen, where the emails can be switched between based on clicking).

Yoneyama does not teach wherein one of the emails is an edition email (reply composition) nor does he teach wherein both the edition email and the reference email (incoming and stored emails) are simultaneously displayed on the screen.

Lee, in a similar field of endeavor, teaches wherein a reply composition is displayed simultaneously with a reference email. (Lee: [0092]) He also teaches wherein the reference emails are incoming mails (Lee: [0027]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lee for having a system capable of displaying both an edition and reference email simultaneously. The teachings of Lee, when implemented in the Yoneyama system, will enable one of ordinary skill in the art to compose email messages without the need to flip back to a reference email. One of ordinary skill in the art would be motivated to utilize the teachings of Lee in the Yoneyama system because "time loss can be reduced" (Lee: [0092]) if the system is implemented effectively.

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Regarding claim 9, this device claim comprises limitations substantially similar to those of claim 8 and the same rationale of rejection is used, where applicable. Yoneyama further teaches wherein

a mail search portion searching for the reference mail stored in said mail storage on the basis of the reference mail designated by the user (Yoneyama: [0011] specifies that the searching is done based on the currently displayed message; [0015] specifies further that the searching is based off the currently displayed message and that the user has control over which message is displayed, thereby designating which message to use as a search basis)

Regarding claim 10, the Yoneyama/Lee system teaches an e-mail editing device comprising:

a mail storage storing data of each of a plurality of emails (Yoneyama: Figure 1, item 204; [0029] specifies that the storage portion stores key words, etc., and then the display portion retrieves past e-mail messages, implying they are stored in the storage portion);

an operation input unit for a user to enter an instruction regarding display of said plurality of emails (Yoneyama: Figure 1, item 3; abstract specifies switching between messages by simply clicking);

a mail search portion searching for an email stored in said mail storage on the basis of data of the email displayed according to said instruction (Yoneyama: Figure 1,

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item 2a; [0011] specifies that the searching is done based on the currently displayed message and its keywords);

a display processor generating edition screen data for displaying the contents of an edition mail (Lee: [0092] specifies a frame contains the reply email, implying its data is generated) whose data is rewritable (Lee: [0033] specifies the reply message can be altered) and reference screen data for displaying said searching email as a reference mail (Yoneyama: abstract specifies using email searches to find reference emails; implying their data is generated) whose data cannot be rewritten (Lee: [0033] specifies that the reference mail cannot be altered) on the basis of said data in response to an instruction given by the user (Lee: [0015] specifies the user clicking "reply" in order to activate the process);

a display displaying a mail edition screen displaying the contents of said edition mail and a mail reference screen displaying the contents of said reference mail on the basis of said edition screen data and said reference screen data. (Lee: [0092] specifies simultaneously displaying the reply email and the reference email)

Regarding claim 11, the Yoneyama/Lee system teaches an email editing device further comprising:

a temporary storage temporarily storing data; (Yoneyama: Figure 1, item 204; Yoneyama: [0029] specifies that the storage portion stores key words, etc., indicating it stores reference emails and other things)

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a reference processor storing object data included in said reference mail to said temporary storage (Yoneyama: [0053] specifies that you can copy from the reference email, implying it is stored in the storage portion; Lee: [0033] specifies that ideally the reference email cannot be altered, implying that the copying would occur from the reference email, not the pasting);

an editor inserting object data stored in said temporary storage into said edition mail (Yoneyama: [0053] specifies that you can paste information into an email; Lee: [0033] specifies that ideally the reply email is alterable, implying the pasting would occur into the reply email).

Regarding claim 12, the Yoneyama/Lee system teaches an email editing device wherein

said mail search portion searches for an email stored in said mail storage on the basis of a reference mail (received/incoming or stored mail) displayed on said mail reference screen. (Lee: [0092] and abstract imply the reference email is an incoming email that is being replied to; Yoneyama: abstract specifies that the searching is done based off a received displayed email; Lee: [0092] specifies that the reference email has its own frame)

Regarding claim 13, the Yoneyama/Lee system teaches an email editing device wherein

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said mail search portion extracts an email whose sender or address matches the sender of said reference mail (Yoneyama: [0013] specifies the searching by keywords; Yoneyama: [0034] specifies the keyword is a sender's name; Yoneyama: [0039] specifies the sender's name is the sender of the currently received message).

Regarding claim 14, the Yoneyama/Lee system teaches wherein

said mail search portion searches for an email stored in said mail storage on the basis of the reference mail designated by the user. (Yoneyama: [0011] specifies that the searching is done based on the currently displayed message; Yoneyama: [0015] specifies further that the searching is based off the currently displayed message and that the user has control over which message is displayed, thereby designating which message to use as a search basis)

Regarding claim 15, the Yoneyama/Lee system teaches wherein

said mail storage stores at least one of transmission time and reception time of said email (Yoneyama: Figure 6f and Figure 6h indicate that search results are returned sorted by date/time information, implying the information is stored)

said mail search portion sequentially extracts emails matching a search condition included in the reference mail designated by the user at said transmission time or said reception time (Yoneyama: [0049] specifies that the messages are switched to whether being earlier or following; Yoneyama: Figures 6f and 6h indicate that the search results

are sorted by date/time; Lee: [0036] specifies that search criteria could include a period of time)

said display processor sequentially switches and displays said extracted emails on the basis of the mail switching operation of the user. (Yoneyama: [0049] specifies that the messages are switched to whether being earlier or following; Figures 6f and 6h indicate that the search results are sorted by date/time)

Regarding claim 16, this device claim comprises limitations substantially similar to those of claim 6 and the same rationale of rejection is used, where applicable.

Regarding claim 17, the Yoneyama/Lee system teaches an email editing device further comprising:

an input detector detecting an input of said mail switching operation (Yoneyama: Figure 1, item 3; Yoneyama: [0049] specifies that following messages are switched to by clicking 'Next' and that earlier messages are switched to by clicking 'Previous');

wherein an email designated by the user is a mail displayed on said mail viewing screen when said mail switching operation is input for the first time (Yoneyama: [0011] specifies that the searching is done based on the currently displayed message; Yoneyama: [0015] specifies further that the searching is based off the currently displayed message and that the user has control over which message is displayed, thereby designating which message to use as a search basis; Yoneyama: abstract specifies clicking to flip through messages).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Fellenstein et al (US 2004/0073616 A1) discloses a method for grouping email replies so that a user can simultaneously view the original sent message with grouped replies.
- b. Fujimoto et al (US 2002/0138584 A1) discloses a method and system for an electronic message bulletin board to arrange conversations to be viewed simultaneously.
- c. Koch et al (US 6,968,362 B2) discloses a system and method for an electronic message bulletin board for use by multiple users and allows notes to be displayed simultaneously.
- d. Moody et al (US 2003/0167310 A1) discloses a system and method for threading email conversations and building storage trees.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Nickerson whose telephone number is 571-270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey Nickerson
TC 2100
Patent Examiner
October 1, 2007

Beatriz Prieto
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